



Attorney Docket No. WIIP:101aUS
U.S. Patent Application No. 09/929,214
Reply to Final Office Action of August 11, 2005
Date: January 5, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent Application No.: 09/929,214

Confirmation No.: 2468

Applicant(s): Burt NOTARIUS et al.

For: **METHOD AND APPARATUS FOR MARKETING AND
COMMUNICATING IN THE WINE/SPIRITS INDUSTRY**

Filed: August 14, 2001

TC/Art Unit: 3622

Examiner: Jean D. JANVIER

Docket No.: WIIP:101aUS

Customer No.: 24041

Certificate of Mailing by First Class Mail

I certify that this correspondence is being deposited on January 5, 2006 with the U.S. Postal Service as first class mail under 37 C.F.R. §1.8 and is addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

C. Paul Maliszewski
Registration No. 51,990

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Honorable Sir:

This Pre-Appeal Brief Request for Review is in response to the Final Office Action dated August 11, 2005 and Advisory Actions dated November 2, 2005 and November 30, 2005. A Notice of Appeal also has been filed this day for the above case.

Arguments begin on page 2 of this paper.

A check in the amount of \$950.00 is enclosed for a Notice of Appeal fee and a Petition and fee for a two month extension of time.

Remarks/Arguments

For the sake of brevity, only independent claims are addressed in this reply. It is understood that arguments regarding the independent claims apply to respective claims dependent from the independent claims.

Clear Errors in the Examiner's Rejections

A. Claim 1 elements: On page 12 of the Amendment and Request for Reconsideration filed October 11, 2005, Applicants detailed the clear error made by the Examiner on page 9, first paragraph in the Final Office Action dated August 11, 2005 (hereinafter referred to as the Final Office Action) regarding Claim 1. The Examiner asserted that Claim 1: “never recites ‘a channel hub analyzing information’ or any ‘channel hub’ whatsoever.” However, Claim 1 as presented in the May 18, 2005 Amendment and Request recites: “**analyzing first information** related to said subset of said set of product offerings **with a computer, where said computer is part of said channel hub** (emphasis added);” In the subsequent Advisory Actions of November 2 and 30, 2005, the Examiner failed to retract this fundamental error in facts and used this error to buttress the final rejections.

In the Final Office Action, the Examiner rejected Claim 1 under 35 U.S.C. §112, second paragraph regarding antecedent basis for “said channel hub.” Applicants amended Claim 1 to recite “a channel hub” in the Amendment and Request filed October 11, 2005. In the Advisory Action dated November 2, 2005, the Examiner failed to enter the amendment to Claim 1. However, this antecedent basis issue has no bearing on the fundamental error made by the Examiner, in particular, since the Examiner has asserted that Claim 1 did not recite any channel hub whatsoever.

B. Amendments in the Request for Reconsideration filed November 30, 2005: In the Advisory Action of November 30, 2005, the Examiner indicated that amendments in the Request for Reconsideration filed November 14, 2005 (hereinafter referred to as the Request) were not accepted (item C on PTOL-303). However, **Applicants did not present any claim amendments in the Request** – only arguments were presented. In the Continuation Sheet, the Examiner made a

series of errors based on the incorrect presumption of amendments in the Request. In the first paragraph, the Examiner refused to reopen prosecution because Applicants allegedly were presenting new interpretations or new claim language. Neither presumption is valid. As shown *supra*, the claims were not amended - the arguments in the Request were based solely on the claims presented in the May 18, 2005 Amendment and Reply, which preceded the Final Office Action. The arguments either repeated or embellished interpretations presented in previous Office Action replies. For example, on pages 6 and 7 of the Request (all page references regarding Applicants' arguments are with respect to the Request unless noted otherwise), Applicants presented further detail regarding previous analyses of grammar and syntax in Claim 1 to help resolve the issues under 35 U.S.C. §112, second paragraph. In the second paragraph, the Examiner again referenced non-existent claim amendments and new interpretations to maintain the final rejections.

C. Finality of Office Action: On page 9, first full paragraph, of the Final Office Action, the Examiner stated that Applicant's arguments, as presented regarding the rejection of Claim 1 under 35 U.S.C. §112, second paragraph and the rejection of Claim 1 over Clarke were not plausible, and therefore, the Examiner made the Office Action final. On page 12, last paragraph, Applicants argued against the finality of the August 11, 2005 Office Action. In particular, Applicants pointed out that the Examiner's arguments regarding Claim 1 and Clark were based on a clear error in facts regarding the channel hub and computer. The finality of the Office Action, which was based on the unsubstantiated rejection and error in fact, is premature.

The Rejection of Claim 1 Under 35 U.S.C. §112, Second Paragraph

In the Final Office Action, the Examiner rejected Claim 1 (including Claims 2-4) under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner has stated that: 1) Claim 1 recites the consumer receiving a payment; and 2) the specification does not support the limitations in the first clause of Claim 1.

The Examiner asserted in the Final Office Action and the Advisory Actions that Claim 1 recites making a payment to a consumer, not to an establishment as asserted by Applicants. Applicants contend that the Examiner is misapplying rules of grammar and syntax to arrive at the preceding conclusion. Further, the Examiner has failed to appreciate portions of the specification supporting Applicant's assertions regarding the subject claim limitations. Applicants have provided arguments to this effect on pages 4 through 7. In particular, there is a phrase-by-phrase analysis of the subject Claim 1 clause on pages 6 and 7.

The Rejection of Claims 1 through 15 Under 35 U.S.C. §102(b)

In the Final Office Action, the Examiner rejected Claims 1-15 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 6,351,738 (Clark).

Regarding Claim 1, at the end of page 8 and beginning of page 9, Applicants show that Clark does not teach a supplier offering to pay a retailer for a solicitation by the retailer to a consumer and that Clark instead teaches a Hub Business Entity (HBE) conveying an incentive to retailers regarding transactions (purchases) between retailers and the supplier. In the remainder of page 9 and page 10, Applicants show that Clark does not teach the Claim 1 elements of a relationship of supplier to retailer and retailer to customer, or a channel hub analyzing information.

Regarding Claims 6, 8, and 10, Applicants show on the top of page 11, that the arguments for Claim 1 regarding the hub analyzing information from a retailer are applicable to these claims. Regarding Claim 12, at the bottom of page 11, Applicants show that Clark does not teach the hub formulating a promotional offer to a consumer, as recited in Claim 12. Regarding Claims 14 and 15, at the top of page 12, Applicants show that arguments regarding Claims 1 and 12 are applicable to Claims 14 and 15.

The Rejection of Claims 1 through 15 Under 35 U.S.C. §102(b)

In the Final Office Action, the Examiner rejected Claims 1 through 15 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,974,396 (Anderson et al.).

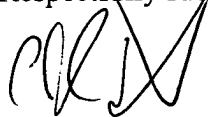
Regarding Claim 1, at the bottom of page 12 through to page 14, Applicants showed that Anderson does not teach the Claim 1 elements of a supplier or any interaction with a supplier. In the middle of page 14, Applicants showed that Anderson does not teach, suggest, or motivate the Claim 1 element of a channel hub linking suppliers, retailers, and customers.

Regarding remaining independent Claims 6, 8, 10, 12, 14, and 15, Applicants showed on pages 14 and 15, 15, 16, 16, and 16 and 17, respectively, that Anderson does not teach at least one element of the respective claims.

Conclusion

For the reasons set forth above, Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested

Respectfully submitted,



C. Paul Maliszewski
Registration No. 51,990
CUSTOMER NO. 24041
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564
Fax No. 716-626-0366

CPM/
Dated: January 5, 2006